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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,174	09/17/2003	Leslie Snyder	SPIRTN.016A	6300

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EXAMINER

MENDOZA, MICHAEL G

ART UNIT PAPER NUMBER

3731

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,174

Applicant(s)

SNYDER ET AL.

Examiner

Michael G. Mendoza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/25/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 39, 40, 46-48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6632239. Although the conflicting claims are not identical, they are not patentably distinct from each other because the structural limitations set forth in Claims 39, 40, 46-48 of the instant application are also claimed in the patent, e.g., an implantable elongated sleeve; at least one suture hole; and a reinforcement structure. The application claims merely adds a feature absent from the patent claim.

The difference between claims 39, 40, 46-48 of the instant application and Claims 1-16 of the patent is a biocompatible material.

However, the patent Claims have the limitation of the implantable. Therefore, it would have been inherent that the device be made of a biocompatible material to allow for implantation into a body.

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3. Claims 49, 55, and 56 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6632239. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claim is merely broader than the patent claim. The structural limitations set forth in Claims 49, 55, and 56 of the instant application are also claimed in the patent, e.g., an implantable elongated sleeve; at least one suture hole; and a reinforcement structure. The applicant has simply failed to claim the limitation of "implantable" in the pending claim and failure to claim a patented element is considered obvious. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

4. Claims 41-43, 44, 45, 50-52, and 53 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6632239 in view of Alferness et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the structural limitations set forth in Claims 41, 43, 44, 50, 52, and 53 of the instant application are also claimed in the patent, e.g., an implantable elongated sleeve; at least one suture hole; and a reinforcement structure. The application claims merely adds a feature absent from the patent claim.

The difference between claims 41, 43, 44, 50, 52, and 53 of the instant application and Claims 1-16 of the patent is a band circumscribing the sleeve.

Alferness et al. disclosed a band circumscribing a sleeve (col. 8, lines 60 to col. 9, lines 1-15).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the band of Alferness et al. to form a strong compressive lock to hold the tissue close to the distal end of the elongated sleeve to resist migration of the device (col. 9, lines 9-15).

5. As to claim 45, Patent No. 6632239 claim 6 teaches the claimed invention except for the band extends radially outwardly. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the band extend radially outwardly, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

6. As to claims 42 and 51, Patent No. 6632239 teaches the structural limitations set forth in Claims 41, 43, 44, 50, 52, and 53 of the instant application are also claimed in the patent, e.g., an implantable elongated sleeve; at least one suture hole; and a reinforcement structure. The application merely adds a feature absent from the patent claims.

The difference between claims 42 and 51 of the instant application and Claims 1-16 of the patent is the limitation of the reinforcement structure having higher tear strength than the elastic material of the sleeve. However, the patent Claims have the limitation of the reinforcement structure having increased thickness. Therefore, it would have been inherent that the reinforcement structure has higher tear strength because of its increased thickness.

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Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (703) 305-3285. The examiner can normally be reached on Mon.-Fri. 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dawson can be reached on (703) 308-4304. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



MM
August 19, 2004



GLENN K. DAWSON
PRIMARY EXAMINER